

REMARKS

By this Amendment, claims 1, 7, and 9 have been amended. No new claims have been added. Claims 1-9 are now pending in the Application.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,084,819 to Dewey et al ("Dewey") in view of the McDonnell article "Paying for Health Eager to Control Health-Care Costs" ("McDonnell") and further in view of U.S. Patent 5,712,984 to Hammond et al ("Hammond"). According to the Office Action, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk and to further modify the system of Dewey and McDonnell in combination with the teaching of Hammond to include means for deleting or changing stored gathered information after it has been stored. This rejection is respectfully traversed.

In order to establish a *prima facie* case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2142. The Office Action fails to establish a *prima facie* case of obviousness at least because none of Dewey, McDonnell, and Hammond, even when considered in combination, teach or suggest all limitations of independent claim 1.

Claim 1, as amended, recites, *inter alia*, "entry means for *interactively* inputting said gathered information" (emphasis added). Dewey does not teach or suggest this limitation. To the contrary, Dewey teaches that "[t]he expert system is adapted to receive input from a remotely completed data collection form" (column 3, lines 14-16). A remotely completed data collection form cannot be considered to be interactive. Furthermore, Dewey teaches away from the combination of an "entry means for interactively inputting said gathered information" because Dewey teaches

that "Many people are not computer literate or worse, are computer phobic, unwilling to deal with a computer. Additionally, most people are reluctant to stand in front of a display screen in public to answer many personal and private questions. Further, while one individual is busy answering questions others are precluded from utilizing the system and may just walk away without using and perhaps benefitting from such a system." (column 1, lines 32-40). Neither McDonnell nor Hammond cure the deficiencies of Dewey.

Furthermore, claim 1, as amended, recites, *inter alia*, "means for verifying whether at least some of said gathered information is *true*" (emphasis added). Dewey does not teach or suggest this limitation. Instead, Dewey merely teaches that "[a]fter the reading data form 18, the system inputs the data to error check unit 34 which verifies that the data form has not been previously submitted to the system and is properly filled out" (column 3, lines 43-46). A form that is properly filled out is not necessarily true, because false information can also be entered while still following the proper technique to fill out the form, (i.e. fill in the appropriate bubbles on a bubble sheet commonly read by optical readers). Neither McDonnell nor Hammond cure the deficiencies of Dewey.

Furthermore, claim 1, as amended, recites, *inter alia*, "means for assigning risk values to each of said weight values that represent levels of insurance risk" and "analyzing means for determining said level of insurance risk such that both a cost and an insurability profile are determined." Dewey does not teach or suggest these limitations. As stated by the Office Action at page 4, "Dewey...does not expressly disclose the use of the system for insurable risk assessment." In fact, Dewey makes no mention whatsoever to insurance. McDonnell does not teach or suggest these limitations either. Instead, McDonnell teaches that "Food division employees at General Mills can reduce their insurance premiums by \$20 a month if they have their

own and their spouses' health assessed. After the assessment, they are given advice about reducing their health risks. If employees want to qualify for the discount the following year, they must score well on several health measures." (paragraph 12). McDonnell also teaches that "Honeywell employees in the Twin Cities can earn a \$200 cash payment by being screened for heart disease and cancer risks and reducing those risks – by losing weight or quitting smoking, for example." (paragraph 14). Therefore, McDonnell only teaches a very general method in which insured's insurance premiums are reduced for having an assessment or a screening. McDonnell does not teach the limitations of claim 1 of a "means for assigning risk values to each of said weight values that represent levels of insurance risk" and an "analyzing means for determining said level of insurance risk such that both a cost and an insurability profile are determined." Hammond does not cure the deficiencies of Dewey in view of McDonnell.

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness, at least because the Office Action has not provided proper motivation to combine Dewey with McDonnell. To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 recites the use of a computer system "for evaluating insurability of at least one individual." According to the Office Action, Dewey does not disclose the use of the system for insurable risk assessment. The Office Action relies on McDonnell to cure this deficiency, stating that:

"it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health

assessments to evaluate insurability and insurance risk. As suggested by McDonnell, one would have been motivated to include this feature to slow the growth of healthcare costs (paragraph 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (paragraph 33)”

The motivation to modify Dewey presented in the Office Action is “to slow the growth of healthcare costs, etc.”; however, McDonnell only teaches that getting health assessments may have these effects. The Office Action does not address whether McDonnell makes any suggestion as to the means of providing such an assessment. McDonnell does not suggest there is a problem with the conventional means of providing a health assessment, namely, going to a doctor. McDonnell does teach, however, that motivating payments are made to insureds for going to “get screened for heart disease and cancer risk.” (paragraph 14) Such actions must take place in a hospital or a doctor’s office and do not suggest the use of an automated, remote, Q&A system such as provided by the present invention, or how to combine a means of providing such information in combination with Dewey. Accordingly, since McDonnell only reports the use of health assessments but teaches towards the use of a hospital/doctor as the means of obtaining the assessment as opposed to using a system such as Dewey, these references provide no teaching of a computer system for performing the invention as claimed.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Dewey does not teach or suggest that the system taught by Dewey may be used in any way with insurance. McDonnell does not teach or suggest any system for reducing insurance premiums that could be combined with the system taught by

Dewey. Therefore, neither Dewey nor McDonnell teaches the desirability of combining McDonnell with Dewey.

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness, at least because Dewey teaches away from being combined with Hammond. It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)

Claim 1 recites the use of a computer system comprising a “means for deleting, adding to, or changing said gathered information subsequent to having received and stored said gathered information.” According to the Office Action, Dewey in view of McDonnell does not disclose this limitation. The Office Action relies on Hammond to cure this deficiency, stating that:

“It would have been obvious to one of ordinary skill in the art to modify the system of Dewey and McDonnell in combination with the teaching of Hammond to include means for deleting or changing stored gathered information after it has been stored. As suggested by Hammond, one would have been motivated to include this feature to ensure that corrupt data does not continue throughout the analytical process (column 6, lines 14-16).”

However, Dewey specifically teaches away from including a “means for deleting, adding to, or changing said gathered information subsequent to having received and stored said gathered information” at claim 1, where the claim requires a “means for preventing the rereading of user responses.” (column 9, line 24). Further, Dewey’s stated objective is to allow “many users to access the system by collecting the data quickly *in one transaction*” and “*immediately generat[ing] and print[ing] user*

specific recommendations in response to the analyzed data.” (emphasis added) (column 1, lines 54-60).

Furthermore, Dewey teaches against a combination with Hammond because Dewey teaches away from using “computers” or “complex systems” while Hammond teaches a system that extensively and exclusively relies on a computer system. Dewey teaches against the use of an administrator-operated computer system designed for lengthy, single-user input use, the reason being, “while one individual is busy answering questions others are precluded from utilizing the system and may just walk away without using and perhaps benefiting from such a system” (column 1, lines 36-40). Dewey further teaches specifically against the use of a PC-style computer since “[m]any people are not computer literate or worse, are computer phobic, unwilling to deal with a computer” (column 1, lines 32-33). The language in Dewey consistently refers to its invention as a “system” and does not describe the invention as a “computer” at any point, but instead teaches against the use of a computer as “complex,” undesirable, and unsuccessful in the art for various reasons (ex., the use of a monitor could allow a passerby to see the user’s information) (column 1, lines 29-39). Hammond, on the other hand, states that “[t]he carrier data file 14 is transferred and loaded onto a system computer 18 maintained and operated by an organization which provides the funding system service to insurance carriers, or, alternatively, operated internally by an insurance carrier. The historical claim data 10 is analyzed and statistical techniques are applied to the data 10 to create statistical models 22 which are later used to predict future costs and durations of the carrier’s active workers’ compensation claims” (column 3, lines 43-51). It can thus be seen that the process taught by Hammond is complex and requires a complex system computer to facilitate this process.

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness, at least because the Office Action has not provided proper motivation to combine Dewey with Hammond because a combination of Dewey with Hammond would render the system of Dewey unsatisfactory for its intended purpose. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP 2143.01(V).

Dewey expressly states its intended use is for a simple, quick, remotely operated, single transaction device. (column 1, lines 47-56). Fig. 1 of Dewey is illustrative of an appropriate system described by Dewey, which does not have any of the common elements of a personal computer, i.e. a mouse, a keyboard, or a monitor but only a box having a first slot for users to enter their forms into and a second slot for the box to print out a response. Accordingly, a finding of a suggestion to modify Dewey to be implemented using a complex computer system as taught by Hammond would render Dewey unsatisfactory for its intended purpose.

Furthermore, the Office Action has not provided proper motivation to combine Dewey with Hammond because the system taught by Dewey already contains a “means for rejecting an improperly or incorrectly marked data form” (Dewey, column 2, lines 20-21) and therefore does not require the “review process” taught by Hammond (Hammond, column 6, lines 14-16). Hammond states that

“[d]ue to the likelihood that large quantities of data will contain numerous errors, whether reporting, clerical, computational or otherwise, the claim records data must undergo a preliminary quality control analysis which searches the data of each individual claim record for errors. Recognizable errors include variables containing invalid codes, inconsistent codes, improper negative values,

illogically high dollar values, etc. For a statistical analyst, or statistician, to become familiar with the data, extensive exposure to the content of the data is required. Questions like the amount of missing data, range of dollar values, diversity in INJURY TYPEs, etc., are answered which provide the basis for understanding the underlying nature of the data. This review process assures that corrupt data does not pass by the analyst's scrutiny." (column 6, lines 2-16).

Therefore, it can be seen that the system of Hammond uses complex data forms that can be filled out with an infinite number of possible answers. Dewey, on the other hand, teaches "a system and method which is efficient and allows many users to access the system by collecting the data quickly in one transaction" (column 1, lines 53-56). Furthermore, the forms taught by Dewey may only be answered by multiple choice as shown in TABLE 1, where it can be seen that the instructions instruct a user to "mark correct circles on form" (column 5, lines 10-35). Therefore, because Dewey relies on multiple choice forms, the "error check unit 34 which verifies that the data form has not been previously submitted to the system and is properly filled out" is sufficient to catch any errors that may arise from a user improperly filling out a form. Thus, there is no need and no motivation to combine a complex data review process taught by Hammond with the simple and adequately reviewed system of Dewey.

For at least the above reasons, neither Dewey alone or in combination with McDonnell and Hammond teach or suggest the limitations of claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Claim 2, 4, and 6, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell and further in view of Hammond. This rejection is respectfully traversed. Claims 2, 4, and 6 depend from claim 1 and thus recites the limitations of claim 1. As described above, Dewey in view of McDonnell and

Hammond fails to teach or suggest the limitations of claim 1. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dewey, McDonnell, and Hammond in view of U.S. Patent 4,975,840 to DeTore et al. ("DeTore"). This rejection is respectfully traversed. Claim 3 depends from claim 1 and thus recites the limitations of claim 1. As described above, there is no suggestion or motivation to combine Dewey and McDonnell or Dewey and Hammond, and Dewey in view of McDonnell and Hammond fails to teach or suggest the limitations of claim 1. Furthermore there is no suggestion or motivation in the prior art to combine DeTore with Dewey, McDonnell, and Hammond. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 5 stands rejected as being unpatentable over Dewey and McDonnell and in further view of the Lynch article "Stay Healthy: Pay Le\$\$ for Health Insurance" ("Lynch"). This rejection is respectfully traversed. Claim 5 depends from claim 1 and thus recites the limitations of claim 1. However, Lynch fails to overcome the above-noted deficiencies of Dewey, McDonnell, and Hammond. Therefore, Applicant respectfully requests that this rejection be withdrawn.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell and further in view of Hammond. This rejection is respectfully traversed. The Office Action states that Dewey teaches a method of a "computer system determining a total value based on said assigned risk values," however the Office Action did not explain where the "said" risk values were disclosed in Dewey (Office Action pg. 7). Accordingly, Dewey does not disclose the limitation of claim 7 of "assigning of risk values by said computer system to each of said weight values that represent levels of insurance risk." Finally, claim 7 has been amended to

overcome the instant rejection much in the same way as claim 1 and is allowable for similar reasons as those discussed above with respect to claim 1. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

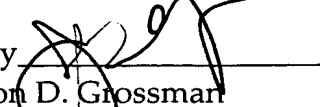
Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell, Hammond, and DeTore. This rejection is respectfully traversed. Claim 8 depends from claim 7 and thus recites the limitations of claim 7. As described above, there is no suggestion or motivation to combine Dewey and McDonnell or Dewey and Hammond, and Dewey in view of McDonnell and Hammond fails to teach or suggest the limitations of claim 1. Furthermore there is no suggestion or motivation in the prior art to combining DeTore with Dewey, McDonnell, and Hammond. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell. This rejection is respectfully traversed. Claim 9 has been amended to overcome the instant rejection much in the same way as claim 1 and is allowable for similar reasons as those discussed above with respect to claim 1. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

In view of the above amendments, applicant believes the pending application is in condition for allowance. Favorable action on the merits is respectfully requested.

Dated: September 19, 2006

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